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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,898	01/14/2005	Olivier J. Poncelet	8423IJH	7126
7590	11/12/2009			
Eastman Kodak Company Patent Legal Staff 343 State Street Rochester, NY 14650-2201			EXAMINER JOY, DAVID J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/12/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/521,898

Filing Date: January 14, 2005

Appellant(s): PONCELET ET AL.

Andrew J. Anderson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 6, 2009 appealing from the Office action mailed January 7, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,548,149	LIU, ET AL.	04-2003
5,916,946	PONCELET, ET AL.	06-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Rejection under 35 U.S.C. §103(a)

Claims 1-3 and 5-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Liu et al. (6,548,149; hereinafter "Liu") in view of the U.S. Patent of Poncelet et al. (5,916,946; hereinafter "Poncelet").

Liu teaches an ink jet recording element comprising a support and an ink jet receiving layer, and the ink jet receiving layer contains a polyvinyl alcohol binder and an aluminosilicate polymer (see Abstract; see also Column 5, Lines 38-53; see also Column 6, Lines 55-63; see also Column 7, Lines 13-26; see also Column 10, Lines 45-55). Liu also teaches that the aluminosilicate used in the ink jet receiving layer has an Al/Si molar ratio of 1:4 to 4:1 (see Column 9, Lines 44-61), and that the use of the aluminosilicate results in the ink jet receiving layer having an enhanced gloss, an enhanced weathering resistance, and that the layer produces images having enhanced quality. In addition, Liu recites that the ink receiving layer, after printing, contains an amount of aluminosilicate particles that is from 50 to 100% by weight of the ink receiving layer and the additional ink-absorbent layer, which clearly meets the broad recitation of an amount between 5 and 95%, as in the present claim (see Column 15, Lines 42-57). In combining the aluminosilicate polymer with the suitable binder, it follows that Liu also provides that a coating composition for the ink-receiving layer is thus obtained. Liu's teachings, however, merely recite a general teaching that aluminosilicate can be used in the ink jet receiving layer to achieve these results.

Poncelet, drawn to an organic/inorganic composite and photographic product containing such a composite, teaches a hybrid, organic/inorganic composite aluminosilicate polymer having an Al/Si molar ratio between 1 and 3, and an Al

concentration between 5×10^{-4} and 5×10^{-2} mol/l (see Column 1, Lines 6-10; see also Column 2, Line 55 – Column 3, Line 9; see also Claim 1). Poncelet also teaches that the organic/inorganic composite aluminosilicate polymer can be used in image-receiving layers and products having these layers applied thereon, and that such layers exhibit enhanced performance characteristics (see Column 1, Lines 6-10; see also Column 3, Lines 50-65; see also Column 4, Lines 6-21). As both Liu and Poncelet are drawn to analogous fields of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to have made the ink jet recording material taught by Liu and to incorporate the composite polymer taught by Poncelet.

Claims 1-3 and 5-22 are viewed as product-by-process claims and hence the methods that the aluminosilicate is created by are not pertinent, unless applicant can show a different product is produced, despite that fact that Liu recites that the inclusion of the aluminosilicate in the ink-receiving layer results in an ink jet recording material that has a high gloss, produces high quality printed images and has a good dye keeping time. Likewise, Poncelet recites that the use of the hybrid, organic/inorganic polymer can be used in image-receiving layers and products having these layers applied thereon, and that such layers exhibit enhanced performance characteristics. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

(10) Response to Argument

Appellant argues that the use of a hybrid aluminosilicate polymer obtained by a specified preparation method is clearly not taught or suggested by either Liu or Poncelet, as such references only disclose use of fully alkoxylated silicon compounds in the preparation of the aluminosilicates thereof. However, Examiner respectfully disagrees with Appellant’s assertion. The present claims are drawn to an article/product (“an ink jet recording element”) that comprises a support and at least one ink-receiving layer, where the ink-receiving layer comprises at least one hydrosoluble binder (e.g., gelatin or polyvinyl alcohol) and at least one hybrid aluminosilicate polymer that is obtained by the specified preparation method. Liu teaches an ink jet recording element that comprises a support and an ink jet receiving layer, and the ink jet receiving layer contains a polyvinyl alcohol binder and aluminosilicate polymer. Liu’s teachings, however, recite a general teaching that an

aluminosilicate polymer can be used in the ink jet receiving layer. Poncelet, which is drawn to an organic/inorganic composite and photographic product containing such a composite, teaches the use of a hybrid, organic/inorganic composite aluminosilicate polymer in image-receiving layers and products having these layers applied thereon.

Consequently, the combined teachings of Liu and Poncelet teach a product that matches that which is presently claimed, though the claimed invention is obtained by a process that is different from that which is taught in the references. Likewise, while the process recites that the composition begins with various substituents, it is noteworthy that there is nothing in the portion of the claim that is directed to the claimed product (and not the product-by-process limitations) that positively recites either the presence of hydrolyzable and non-hydrolyzable substituents in the formed aluminosilicate polymer product, or that certain substituents groups are retained by the final product that is formed. "The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to application to come forward with evidence establishing an unobvious difference between the claimed

product and the prior art product." *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See also, MPEP §2113.

Appellant also argues that the Examples of the present application clearly demonstrate improved performance with respect to dye keeping properties and gloss for ink jet recording elements employing a hybrid aluminosilicate polymer obtained in accordance with the invention. While Examiner is not contesting that Appellant's Examples show that the inventive composition achieves improved performance, a direct comparison between the hybrid aluminosilicate polymer product taught by the prior art of record and that which is presently claimed is nonexistent. Appellant has not provided a comparative evidentiary showing that patentably distinguishes the claimed invention from the prior art of record. As such, it remains unclear as to why the hybrid aluminosilicate polymer that is taught in the prior art is not encompassed by the polymer that is presently claimed.

Further, Appellant argues that the proposed combination of teachings of Liu and Poncelet would not result in the claimed invention, and that such combination would in any event not have been suggested to one skilled in the art because Poncelet and Liu are directed towards different fields of invention. Similarly, Appellant also argues that no

reasonable motivation for the proposed combination has been proposed and that a *prima facie* case of obviousness has not been established. However, Examiner respectfully disagrees with Appellant's assertions. It has been established that according to MPEP §2141.01(a), a reference may be relied on as a basis for rejection of an applicant's invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it may be in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Poncelet is, therefore, a reasonably pertinent reference, because it teaches the application of a hybrid organic/inorganic composite aluminosilicate polymer into all types of photographic coating layers and photographic products (i.e., which can be deemed to be imaging elements), and it is that application that results in the layers exhibiting enhanced performance characteristics, which is a function/feature that is especially pertinent to both the teachings of Liu, which is drawn to an ink jet recording material (which can also be deemed to be an imaging element) and the presently claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David J. Joy/

Examiner, Art Unit 1794

Conferees:

/Callie E. Shoshof/

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/William A. Krynski/

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